

REMARKS

Claims 1-2 are pending in the application. Claim 1 and the Abstract of the Disclosure are herein amended. No new matter has been presented.

Objection to the Specification

In item 4, the Abstract was objected to because the use of the word “eccentrically.”

The Abstract of the Disclosure has been amended to overcome this objection. Thus, this objection should be withdrawn.

Rejections under 35 USC §102(b)

Claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by Shimizu et al. (U.S. Patent No. 4,816,308).

Claims 1 and 2 were rejected under 35 U.S.C. 102(b) as being anticipated by Collette et al. (U.S. Patent No. 5,759,653).

Requirements of Anticipation

A claim is **anticipated only if each and every element as set forth in the claim is found**, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Responding to Applicants’ previous response, the Examiner alleged as follows:

Applicant argues that the preforms taught by Shimizu et al. and Collette et al. are "completely different". However, regardless of whether or not there are differences, **the structures taught by both Shimizu et al. and Collette et al. independently read on the structure claimed by Applicant.** Applicant's arguments appear to relate to how the performs are made and used, and do not appear to allege any structural differences.

(Office Action, item 13).

However, “the structures taught by both Shimizu et al. and Collette et al. independently read on the structure claimed by Applicant” does not necessarily indicate that the present claimed invention is anticipated in Shimizu et al. or Collette et al. The MPEP explains as follows:

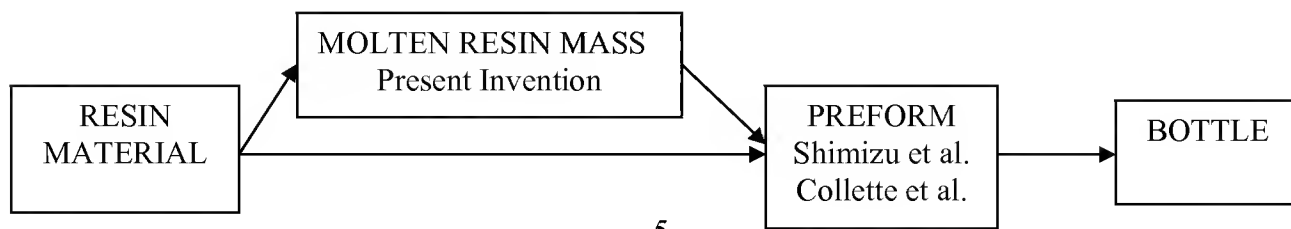
A genus does not always anticipate a claim to a species within the genus. However, **when the species is clearly named, the species claim is anticipated** no matter how many other species are additionally named. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) (The claimed compound was named in a reference which also disclosed 45 other compounds. The Board held that the comprehensiveness of the listing did not negate the fact that the compound claimed was specifically taught. The Board compared the facts to the situation in which the compound was found in the Merck Index, saying that "the tenth edition of the Merck Index lists ten thousand compounds. In our view, each and every one of those compounds is 'described' as that term is used in 35 U.S.C. § 102(a), in that publication."). Id. at 1718.

(MPEP, 2131.02). **A genus always reads on a species.** However, disclosure of a genus does not necessarily anticipate a claim to a species within the genus as the MPEP explains. The presently claimed invention is not clearly named or described in neither Shimizu et al. nor Collette et al.

The issue about anticipation would be whether the present claim encompasses the prior art rather than whether disclosure of the prior art reads on the present claimed subject matter. The present claims do not encompass the subject matter disclosed in Shimizu et al. and Collette et al.

Differences from Shimizu et al. and Collette et al.

First, it should be noted that the present invention is directed to a “molten resin mass” but not a preform. Please see the following chart.



Shimizu et al. and Collette et al. discuss the “preform” but not the “molten resin mass.”

A “molten resin mass” is intermediate material which is to be formed into a “preform.” The molten resin mass is typically obtained from a plurality of resin materials by extruding heat-melted resin through a die head. The molten resin mass is then formed into a preform by compression molding. The preform is formed into a bottle by blow molding.

In the case of a bottle without an intermediate resin layer, the preform is usually directly formed from the resin material through injection molding. The present invention, however, is related to a process of manufacturing a bottle with an intermediate resin layer. In the process, the preform is formed from a molten resin mass through compression molding. The process has advantages that the compression molding can be carried out under lower temperature and lower pressure, resulting in less deterioration of the resin.

In order to obtain a bottle with an intermediate resin layer uniformly distributed between the outer layer and the inner layer, the intermediate resin layer is required in the preform to be precisely and uniformly positioned between the outer layer and the inner layer. The present inventors discovered that the distribution of the intermediate resin layer in the preform significantly depends on the shape of the intermediate resin in the molten resin mass. The present inventors also found the optimal shape and the location of the intermediate resin in the molten resin mass.

Re: Shimizu et al. and Collette et al.

Shimizu et al. and Collette et al. disclose a multilayered preform which is obtained by a injection molding process (see Shimizu et al., Figs. 1-4, column 3, lines 3-8; also see Collette et al., Figs. 4 and 5). But these references discuss nothing about the molten resin mass. It would be

meaningless to compare the shape of the intermediate resin layer in a preform with the intermediate resin in a molten resin mass.

Therefore, neither Shimizu et al. nor Collette et al. teaches or suggests the present invention as set forth in claim 1.

For at least these reasons, claim 1 patentably distinguishes over Shimizu et al. and Collette et al. Claim 2, depending from claim 1, also patentably distinguishes over Shimizu et al. and Collette et al. for at least the same reasons.

Claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by Kuwabara et al. (JP 03-234604) (English abstract filed with IDS).

Claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by Kuwabara et al. (JP 03-234604).

Responding to Applicants' previous response, the Examiner alleged as follows:

Applicant argues that Kuwabara et al. "does not indicate that the layer distribution of the intermediate resin layer of the molten resin mass is formed as recited in the present claims".

However, **the structure taught by Kuwabara et al. reads on the structure claimed by Applicant.** It is not clear to what "layer distribution" Applicant refers, but the structure taught by Kuwabara et al. reads on the structure claimed by Applicant. Applicant also argues that the structure recited in the last four lines of claim 1 is not taught by Kuwabara et al. without explaining how this is so.

However, as stated in the previous rejections of claim 3, Kuwabara et al. teaches an interlayer having structure that corresponds to the claimed structure. Compare figures of English abstract with Applicant's Fig. 1 (note the top of interlayer of Kuwabara et al. on either side is curved) and compare figures 3A-3D with Applicant's Fig. 1 (note the top of interlayer of Kuwabara et al. on either side is curved).

(Office Action, item 14).

Thus, like the rejection over Shimizu et al. and Collette et al., these rejections also based on a similar allegation that “the structure taught by Kuwabara et al. reads on the structure claimed by Applicant.” The same thing as discussed above can be said about these rejections.

Although Kuwabara et al. discloses compression molding process of multilayered molten resin mass, it does not disclose how the intermediate resin should be controlled in order to obtain a bottle with an intermediate resin layer uniformly distributed between the outer layer and the inner layer. Kuwabara et al. does not teach or suggest “wherein the second resin is shaped such that Z (total length) $\geq y$ (length of umbrella part of second resin) $\geq L$ (length of central part of second resin), and $1 > d_o$ (maximum outer diameter of second resin in direction of circumference)/ D (outer diameter of multilayered molten resin mass in direction of circumference) ≥ 0.5 ,” as recited in claim 1.

For at least these reasons, claim 1 patentably distinguishes over Kuwabara et al.

Rejections under 35 USC §103(a)

Claim 2 was rejected under 35 U.S.C. 103(a) as being obvious over Shimizu et al. (U.S. Patent No. 4,816,308).

Claim 2, depends from claim 1. As discussed above, claim 1 patentably distinguishes over Shimizu et al. Therefore, claim 2 also patentably distinguish over Shimizu et al. for at least the same reasons.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
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